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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,569	01/30/2004	Roy Lim	MSDI-219/PC902.00	8897
52196	7590	11/14/2008		
KRIEG DEVALUT LLP			EXAMINER	
ONE INDIANA SQUARE, SUITE 2800			RAMANA, ANURADHA	
INDIANAPOLIS, IN 46204-2709				
			ART UNIT	PAPER NUMBER
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			11/14/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/769,569	<b>Applicant(s)</b> LIM ET AL.
	<b>Examiner</b> Anu Ramana	<b>Art Unit</b> 3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 01 May 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3,4,6-20,50,52-58,91,95-116 and 120-137 is/are pending in the application.

4a) Of the above claim(s) 19,53-56,105,120 and 130 is/are withdrawn from consideration.

5) Claim(s) 125-129 and 131-134 is/are allowed.

6) Claim(s) 1,3,4,6,7,10-13,20,50,52,57,58,91,95-99,106,108,109,121-124 and 135-137 is/are rejected.

7) Claim(s) 8,9,14-18,100-104,107 and 112-116 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 1/30/04 is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

### **DETAILED ACTION**

The indicated allowability of claims is withdrawn in view of the new rejections made in this action. The Examiner sincerely apologizes for any inconvenience caused to the Applicant by this action.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 4, 6, 91, 97, 136 and 137 are rejected on the ground of nonstatutory obviousness-type double patenting as being separately unpatentable over each of claims of 2, 40, and 58 of U.S. Patent No. 6,530,929.

Claim 20 is rejected on the ground of nonstatutory obviousness-type double patenting as being separately unpatentable over each of claims of 13 and 27 of U.S. Patent No. 6,530,929.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claims of the present

application and the patented claims is that the patented claims are more specific. Thus the invention of the patented claims is in effect a "species" of the "generic" invention of the claims of the present application. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

Claims 1, 3, 4, 6, 7, 91 and 97 are rejected on the ground of nonstatutory obviousness-type double patenting as being separately unpatentable over each of claims 4, 12 or 26 of U.S. Patent No. 7,011,660.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claims of the present application and the patented claims is that the patented claims are more specific. Thus the invention of the patented claims is in effect a "species" of the "generic" invention of the claims of the present application. It has been held that the generic invention is "anticipated" by the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the present application are anticipated by the patented claims, they are not patentably distinct from the patented claims. The Examiner notes that the patented claims recite structural elements that are fully capable of performing the recited function in the claims of the present application.

Claim 20 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over each of claims 4 or 12 or 26 of U.S. Patent No. 7,011,660 in view of Sherman (US 5,797,911).

Each of the patented claims discloses all elements of the claimed invention except for a multi-axial or a poly-axial screw having a yoke portion.

Sherman teaches a multi-axial screw with a yoke portion (Fig. 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the device of patented claim 26 to grip an anchor such as a multi-axial or poly-axial screw, as taught by Sherman, since the use of such a screw is well known in the medical arts for flexibility of angular positioning of the screw in bone.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, 6, 10-11, 20, 50, 52, 57-58, 91, 95-99, 106, 108-111, 121-124, and 135-137 are rejected under 35 U.S.C. 102(e) as being anticipated by Justis et al. (US 6,530,929).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Justis et al. disclose a tool or instrument including: an inserter 24; anchor extensions (30a, 30b) capable of being mounted to a screw or "anchor" including a sleeve or "first member" and a second member being structured and configured to be axially movable with respect to first member wherein second member is received in a passage in the first member; a proximal housing with a drive member that is used to move second member with respect to the first member; and wherein inserter is used to move a connecting element in engagement with anchor (Fig. 1, cols. 5-8, and col. 9, lines 1-49).

Justis et al. further disclose each anchor extension to have an first member 40 and a second member 53 wherein the second member has a pair of jaws 52 (Fig. 4).

Claims 10-13, 20, 91, 96-98, 136 and 137 are rejected under 35 U.S.C. 102(e) as being anticipated by Shluzas et al. (US 7,004,947).

Shluzas et al. disclose a tool or instrument including: an inserter 290; an anchor extension capable of being mounted to a screw or "anchor" 236 including a sleeve or "first member" 50 and a second member 230 being structured and configured to be axially movable with respect to first member 50 wherein second member 230 is received in a passage in the first member; a proximal housing 84 with a drive member 212 that is used to move second member with respect to the first member; and wherein inserter 290 is used to move a connecting element 240 in engagement with anchor 236 (Fig. 6, col. 5 lines 49-67, col. 6 and col. 7, lines 1-28).

Regarding claim 12, Shluzas et al. disclose a limit member or "locking mechanism" 82 that limits movement of handle 38 toward to base portion 50 (col. 3, lines 54-64).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
November 10, 2008

/Anu Ramana/  
Primary Examiner, Art Unit 3775